

100% AVAILABLE COPY

REMARKS

Claims 1-66 are pending in the present application. Claims 1-59 have been amended. New claims 67-105 have been added. New independent claim 67 features a steerable truck assembly similar to features already considered, such as with respect to claim 34. The other new claims depend from new claim 67 and only recite features found in original claims. Support for the new claims can be found throughout the application as filed. No new matter has been added.

Rejection of Product Claims Under 35 U.S.C. §102

Claims 1-2, 6-9, 11, 22-24, 27, 57, are rejected under 35 U.S.C. §102(b) as being anticipated by Capria (US 5,249,376). Applicant respectfully traverses this rejection, for at least the following reasons.

Claims 1-59 have been amended to clarify that the roller is positioned so as to enable personal locomotion. Claims 1 and 57-59 have been amended to make clear that the rollers are positioned so as to enable rolling sideways along a support surface as a mode of personal locomotion. Such structure is disclosed throughout the applicant's specification and drawings.

Capria discloses a shoe with an array of rollers under the heel, to enable small lateral motions of the heel as it engages the floor at an angle, to help avoid ankle injury. Capria's rollers are situated to pivot the wearer's heel around the ball of the foot, along an arc. None of the rollers in Capria's full shoe configuration are positioned to enable personal locomotion along a support surface, as all rollers together enable only arcuate motion. Therefore, Capria fails to anticipate the claimed structure.

Furthermore, the invention as recited in these rejected claims would have been non-obvious to one of ordinary skill in the art. Capria lacks any suggestion that the rollers of his heel device could be rearranged to enable a mode of lateral personal locomotion, and provides no motivation to do so. Capria addresses the problem of torsion injuries to lower extremities, and there is nothing to suggest that his roller arrangement could or should be modified, other than to further reduce torsional injury.

BEST AVAILABLE COPY

Rejection of Claims Under 35 U.S.C. §103

Examiner rejects all of claims 3-5, 10, 12-21, 25, 26, 28-56, and 58-60 as either obvious over Capria by itself, or in combination with one or more of Adams (US 6,450,509), Chu (US 6,412,791), Kubierschky (US 5,443,277), and Roderick et. al. (US 5,967,552). Applicant respectfully traverses this rejection.

Claims 34 and 60 are rejected under 35 U.S.C. §103(a) as obvious over Capria in view of Kubierschky. Applicant respectfully traverses this rejection, as Kubierschky does not provide the recited roller arrangement notably missing from Capria, as discussed above, and therefore does not complete a prima facie case of obviousness.

Furthermore, Applicant submits that the particular feature recited by claim 34, in the context of the invention as recited in claim 1, represents an advance in the art not motivated by either of these cited references, in that it enables steering during lateral personal locomotion along a support surface. Such an arrangement is clearly not suggested by the prior art of steerable skate wheels that only redirect the forward motion of the shoe.

Claim 36 is rejected under 35 U.S.C. §103(a) as obvious over Capria in view of Adams, and in further view of Kubierschky. Applicant respectfully traverses this rejection, as neither Adams nor Kubierschky provide the recited roller arrangement missing from Capria. Both Adams and Kubierschky fail to disclose a structure that induces yaw when traveling in a sideways direction. Thus, this combination of references does not complete a prima facie case of obviousness.

Claims 13-15, 28-33, and 52-56 are rejected under 35 U.S.C. §103(a) as being obvious over Capria in view of Roderick et. al. Applicant respectfully traverses this rejection, as Roderick fails to supply the roller arrangement missing from Capria. Roderick does show an inline skate with a recessed roller for rolling sideways on a rail, but Roderick does not suggest placing such a roller on a walking shoe, to extend below the sole as a means of lateral locomotion. Therefore, as neither reference provides a motivation for the suggested combination, Applicant respectfully requests that the rejection be reconsidered.

~~NOT AVAILABLE COPY~~

With respect to these and the remaining claims rejected under 35 U.S.C. §103(a) as obvious over Capria in view of either Chu or Adams, Applicant respectfully requests that the rejections be reconsidered in light of the above remarks concerning Capria. Neither Chu nor Adams teaches or discloses any arrangement of rollers which can support sideways personal locomotion. Thus, these references fail to make up the deficiencies of the Capria reference as applied to the base claims.

Rejection of Method Claims Under 35 U.S.C. §102

Claims 61-66 are directed towards a method of personal locomotion. The Examiner states:

With regards to claims 61-66, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to a mere claiming of a use of a particular structure. *Ex Parte Pfeiffer*, 1962, C.D. 408 (1961).

Respectfully, the Examiner misinterprets the holding in *Ex Parte Pfeiffer*. In support of the quote taken from *Ex Parte Pfeiffer* by the Examiner, The Patent Office Board of Appeals held that “new use in [sic] not among the categories of patentable inventions specified in 35 U.S.C. 101.” Respectfully, the Examiner has taken this statement of the law out of context. Section 101 of The Patent Act specifically allows patenting of new uses. The authority cited by *Ex Parte Pfeiffer* for this proposition, namely *Application of Moreton*, and *In re Fong*, both written by Judge Rich, simply stand for the fact that when a new use is invented, it must be claimed as a process, not as a use per se. Judge Rich makes this point clear:

But since one cannot claim a new use per se, because it is not among the categories of patentable inventions specified in 35 U.S.C. § 101, it is claimed as a method, as permitted by 35 U.S.C. § 100(b). This mere matter of form should have no effect on patentability. *Application of Moreton*, 288 F.2d 708, 709 (C.C.P.A. 1961)

Further, *Ex Parte Pfeiffer* is factually distinct from the present situation. The applicant-appellant in *Ex Parte Pfeiffer* sought to distinguish a method of transferring fluid material from an airplane to the ground by claiming various release heights and describing properties of the bag as it impacts the ground. The Board of Appeals in *Ex Parte Pfeiffer* rejected these claims because the

Applicant : John A. Roderick
Serial No. : 10/081,388
Filed : February 20, 2002
Page : 19 of 19

At ~~Att~~ey's Docket No.: 05211-018001

NOT AVAILABLE COT

properties were inherent in the prior art. The present claims are directed towards a method or personal locomotion. They do not claim merely a use of the present invention.

Even if the Examiner were correct on this point, Capria fails to anticipate the rejected method claims because he does not disclose or suggest each and every element of the claims. For example, Capria fails to disclose "repositioning the shoes to engage the rollers against the support surface, to roll in the desired direction at an angle to the normal walking direction defined by the shoes" or even a structure that *could* be used for such a method. The shoe disclosed in Capria will pivot around the ball of the foot, with the heel circumscribing a short arc while the forefoot remains translationally stationary. Thus, Capria fails to encompass each and every element of the rejected independent method claim.

Applicant asks that all claims be allowed. The undersigned representative is available for a phone conference at the Examiner's convenience, if the Examiner feels that such may be helpful. Enclosed is a \$393 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: August 8, 2003



James W. Babineau
Reg. No. 42,276

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906